

REMARKS

Claims 1-6 are pending in the present application. The Examiner has rejected claim 1 under 35 U.S.C. §102, and rejected claims 2 and 4-5 under 35 U.S.C. §103. The Examiner indicated that claim 3 would be allowable if rewritten in independent form to include the limitations of its base claims. Applicants thank the Examiner for so indicating, but urge that claims 1-2 and 4-6 are allowable for the reasons presented below.

The § 102 Rejections.

Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 5,909,516 (Lubin).

Applicants respectfully traverse these rejections.

In order for a reference to anticipate a claim under § 102, that reference must disclose every claimed limitation of the claim, either explicitly, or under the principle of inherency.

Claim 1 is directed to a method for testing the eye diagram characteristics of a communications chip. The method includes the steps of sending a precondition signal from a mainframe computer to a chip being tested, reading GLPF signals from the chip being tested, digitizing and normalizing the GLPF signals, reconstructing an eye diagram according to the normalized GLPF signals, analyzing the errors between the parameters of the eye diagram and a predefined specification, and then deciding whether the chip is valid based on the error analysis.

Lubin is directed to a method and apparatus for decomposing an input signal into units of local contrast. The input signal can be an image stream or any other time varying signal, such as an audio signal. Lubin's apparatus includes a signal processing section, which is preferably a general purpose computer executing a software application that can perform the signal processing. There is, however, no positive recitation in Lubin that the apparatus is used for testing communications chips, or can transmit a signal to a another device, such as a chip being tested. Thus, Applicants urge that the Examiner is incorrect in asserting that Lubin discloses sending a precondition signal to a chip under test. Secondly, although Lubin's signal processing section uses a GLPF to analyze the input signal, this is distinct from Applicants' invention wherein a GLPF signal is received

from the chip being tested. Furthermore, as stated previously, there is no disclosure in Lubin of an eye diagram being reconstructed according to a normalized GLPF signal since there is no disclosure of an eye diagram anywhere in Lubin, nor is there any disclosure of an error analysis of the eye diagram parameters. Finally, there is no disclosure of deciding whether a chip is valid based on the error analysis, since there is no disclosure in Lubin of a chip being tested.

Since there is no disclosure in Lubin of a chip being tested, of sending a signal from a computer to the chip being tested and reading a GLPF signal from the chip, of reconstructing and analyzing an eye diagram according to a normalized GLPF, or of deciding whether to reject a chip based on the eye diagram analysis, Lubin does not anticipate Applicants' claim 1. Reconsideration and withdrawal of this § 102 rejection are respectfully requested.

The § 103 Rejections.

Claims 4-5 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Lubin in view of United States Patent Application No. 09/823,795 (Yamazaki). Claims 2 and 6 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Lubin in view of Yamazaki and further in view of United States Patent No. 4,268,861 (Schreiber, *et al*). Applicants respectfully traverse these rejections. Applicant urges that the Examiner has failed to establish a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the combination of the prior art references must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not be based on the Applicants' disclosure.

As stated above, Lubin fails to disclose an apparatus for testing eye diagram characteristics, and thus lacks means for reconstructing an eye diagram by overlapping a series of GLPF signals into a cycle period of the eye diagram, and an error comparison

means for determining if parameter errors are in the allowable range. Although Lubin's device includes an A-to-D convertor, it lacks a means for capturing GLPF signals of a chip being tested. The Examiner concedes that Lubin does not disclose a mechanical arm, but cites Yamazaki as disclosing the same. However, Yamazaki also fails to disclose an apparatus for testing eye diagram characteristics, and thus fails to remedy the other deficiencies of Lubin discussed above.

Thus, since the combination of Lubin and Yamazaki fails to disclose or suggest all of the claim limitations of Applicants' claim 4, Applicants' claim 4 is not *prima facie* obvious over the combination of Lubin and Yamazaki. Reconsideration and withdrawal of this § 103 rejection are respectfully requested.

Claim 5 depends from claim 4, and is thus patentable for the same reasons as claim 4. Reconsideration and withdrawal of this § 103 rejection are respectfully requested.

Claims 2 and 6 depend from, respectively, independent claims 1 and 4, and are each patentable for the same reasons as their respective base claim. Reconsideration and withdrawal of these § 103 rejections are respectfully requested.

Conclusion

Applicants urge that claims 1-6 are in condition for allowance. Early and favorable action is earnestly solicited. If the Examiner believes that issues can be resolved through a telephone interview, the Examiner is urged to call the undersigned at the telephone number listed below.

Respectfully submitted,

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